IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of: Kenneth D. Simone, Jr.

Serial No.:   09/658,298

Filed: September 8, 2000

Group No.:   2142

Confirmation No.   3516

Examiner: Beatriz Prieto

Title: METHOD AND APPARATUS FOR COMMUNICATING

                              DURING AUTOMATED DATA PROCESSING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

CORRECTED APPEAL BRIEF

Appellant has appealed to this Board from the decision of the Examiner, contained in a Final Office Action mailed March 14, 2006 (*"Final Office Action"*) and the Advisory Action mailed May 23, 2006 (*"Advisory Action"*), finally rejecting Claims 1-10, 12, and 14. Appellant filed a Notice of Appeal and Pre-Appeal Brief Request for Review on June 12, 2006. Appellant received a Notice of Panel Decision from Pre-Appeal Brief Review dated July 12, 2006, rejecting Claims 1-10, 12, and 14. Appellant respectfully submits this Appeal Brief for consideration of the Board.

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REAL PARTY IN INTEREST

The real party in interest for this Application under appeal is Corel Corporation.

<u>RELATED APPEALS AND INTERFERENCES</u>

The Appellant, the undersigned Attorney for Appellant, and the Assignee know of no applications on appeal that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-10, 12, and 14 were rejected by the *Final Office Action*. At the time of the *Final Office Action*, Claims 11 and 13 stood canceled. Appellant presents all pending claims for appeal – Claims 1-10, 12, and 14 – and sets forth these claims in Appendix A.

STATUS OF AMENDMENTS

The claims on appeal and which appear in Appendix A of this Appeal Brief represent the form of the claims as of the time of the *Final Office Action* dated March 14, 2006. Appellant filed no amendments to the claims after the *Final Office Action*.

SUMMARY OF CLAIMED SUBJECT MATTER

The traditional approach for carrying out image processing involves manually adjusting images on an image-by-image basis using image processing software that requires extensive operator interaction. *Specification*, p. 3, ll. 4-8. A less common approach includes hard-coding software routines in line-by-line source code. *Id.* at p. 3, ll. 12-14. However, these approaches have required a relatively high level of local human involvement. *Id.* at p. 3, ll. 24-29.

Embodiments of the present invention provide a method and apparatus for facilitating the automated processing of image data in a manner which reduces the level of human involvement. *Id.* at p. 5, ll. 2-7. A project definition defines how data obtained from files storing images will be processed. *Id.* at p. 8, ll. 6-7. A project definition may recognize source modules, branch modules, action modules, and destination modules. *Id.* at p. 10, ll. 11-17; Figure 1. These modules may define where to find data for processing, which data should be processed, what processing should be performed on the data, and where to put processed data. *Id.* at p. 14, ll. 15-21. For example, processing an image may include beveling, blurring, and/or tinting an image. *Id.* at p. 27, ll. 1-16; p. 27, ll. 17-29; p. 35, ll. 27-34. Processing may also include adding an image and/or text to another image. *Id.* at p. 35, ll. 16-26; p. 40, ll. 1-15. These modules may each correspond to one of a plurality of predetermined function definitions. *Id.* at Figure 14, item 537; p. 89, ll. 3-16. The input port(s) and the output port(s) of modules included in a project definition can be bound together to create binding definitions. *Id.* at p. 9, ll. 24-33. So as to facilitate their creation, project definitions may be visually represented in a variety of different ways. *Id.* at p. 44, ll. 27-30; p. 91, ll. 13-21; Fig. 6-8.

After its creation, the project definition may be executed. The description of Figure 8 details an example of a project definition's execution. *Id.* at p. 54-62. An imaging server (221) may execute the project definition. *Id.* at p. 64, ll. 18-20; Figure 9. One of the modules of the project definition may automatically send a communication to a remote device after editing a predetermined number of images. *Id.* at p. 56, ll. 16-34. For example, this module may be a send email module (131). *Id.* at Figure 8; p. 37, ll. 24-33.

The present claims provide for storing a project definition, executing the project definition, and automatically transmitting a communication to a remote device through a

communication link after editing the image data during execution of the project definition, wherein transmitting the communication occurs after editing a predetermined number of images. As an example of this operation, Figure 14 illustrates a graphical user interface displaying a project definition according to one embodiment. The independent claims each include elements addressing portions of the components, storing, executing, and operation of a project definition.

A.   Claim 1 - Independent

A method, comprising the steps of:

providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;

storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

executing said project definition; and

automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images.

See, e.g., Figure 1 (14, 21, 22, 23, 26, 27, 31, 32, 33, 34, 37, 38), Figure 2 (3, 4, 5), Figure 6 (71, 72, 73, 74, 77, 78, 79), Figure 7 (71, 82, 83, 84), Figure 8 (121, 122, 126, 129, 131, 132, 136, 138, 141, 142, 143, 146, 147, 148, 151, 152, 156, 157, 161, 162, 166, 168, 169, 171, 172, 176, 177, 181, 186, 187, 191, 192, 196), Figure 9 (206, 207, 208, 211, 216, 217, 221, 222, 223, 226, 227, 231, 232, 241, 242, 247, 251, 252, 256, 257, 258, 277, 281, 282, 283, 284, 286, 287, 291, 292, 296, 451, 452, 456, 457), Figure 11 (367, 368, 371, 372),

Figure 13 (491), Figure 14 (101, 521, 526, 527, 528, 529, 536, 537, 541, 542, 543, 544), Figure 15 (101, 102, 103, 104), Figure 16 (581, 582, 586, 591, 592, 587), Figure 17 (601), Figure 18 (651); and the Specification at 8:1-15, 9:13-33, 10:1-22, 10:23-11:13, 13:21-17:17, 43:27-45:18, 45:19-46:12, 54:15-62:10, 62:11-73:6, 74:10-76:20, 81:13-85:2, 86:27-93:32, 93:33-94:25, 95:18-31; *see also* Tables 1-5.

B.   Claim 7 - Independent

A computer-readable medium encoded with a computer program which recognizes a set of predetermined function definitions that are different, at least one of said predetermined function definitions defining a function for editing image data, said program being operable when executed to facilitate:

storing of a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

execution of said project definition; and

automatic transmission of a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmission of said communication occurs after editing a predetermined number of images.

See, e.g., Figure 1 (14, 21, 22, 23, 26, 27, 31, 32, 33, 34, 37, 38), Figure 2 (3, 4, 5), Figure 6 (71, 72, 73, 74, 77, 78, 79), Figure 7 (71, 82, 83, 84), Figure 8 (121, 122, 126, 129, 131, 132, 136, 138, 141, 142, 143, 146, 147, 148, 151, 152, 156, 157, 161, 162, 166, 168, 169, 171, 172, 176, 177, 181, 186, 187, 191, 192, 196), Figure 9 (206, 207, 208, 211, 216, 217, 221, 222, 223, 226, 227, 231, 232, 241, 242, 247, 251, 252, 256, 257, 258, 277, 281, 282, 283, 284, 286, 287, 291, 292, 296, 451, 452, 456, 457), Figure 11 (367, 368, 371, 372),

Figure 13 (491), Figure 14 (101, 521, 526, 527, 528, 529, 536, 537, 541, 542, 543, 544), Figure 15 (101, 102, 103, 104), Figure 16 (581, 582, 586, 591, 592, 587), Figure 17 (601), Figure 18 (651); and the Specification at 8:1-15, 9:13-33, 10:1-22, 10:23-11:13, 13:21-17:17, 43:27-45:18, 45:19-46:12, 54:15-62:10, 62:11-73:6, 74:10-76:20, 81:13-85:2, 86:27-93:32, 93:33-94:25, 95:18-31; *see also* Tables 1-5.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   Appellant requests that the Board review the Examiner's rejection of Claims 1-10, 12 and 14 under 35 U.S.C. § 103(a) as unpatentable over Workflow Management Coalition the Workflow Reference Model, Hollingsworth D., TC00-1003, Jan. 95 ("*Hollingsworth*") in view of U.S. Patent No. 5,907,837 issued to Ferrel, et al. ("*Ferrel*") in further view of U.S. Patent No. 6,628,824 issued to Belanger ("*Belanger*").

II.   Appellant requests that the Board review the Examiner's rejection of Claim 1 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ARGUMENT

I.   **Section 103 Rejection: Claims 1-10, 12, and 14 include limitations that are not taught or suggested by the proposed *Hollingsworth-Ferrel-Belanger* combination, and the proposed combination is improper.**

The Examiner rejects Claims 1-10, 12, and 14 under 35 U.S.C. § 103(a) as unpatentable over Workflow Management Coalition the Workflow Reference Model, Hollingsworth D., TC00-1003, Jan. 95 (*"Hollingsworth"*) in view of U.S. Patent No. 5,907,837 issued to Ferrel, et al. (*"Ferrel"*) in further view of U.S. Patent No. 6,628,824 issued to Belanger (*"Belanger"*). To establish a *prima facie* case of obviousness, there must be a suggestion or motivation in the prior art to modify or combine the references, and the combination of reference must teach or suggest all elements of the rejected claims. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner's rejection of Claims 1-10, 12, and 14 under 35 U.S.C. § 103 fails both of these requirements. First, even if the combination were proper, the proposed *Hollingsworth-Ferrel-Belanger* combination fails to teach or suggest all elements of the claims. Second, there is no suggestion or motivation in the cited references or in the prior art to combine *Hollingsworth*, *Ferrel*, and *Belanger*. Additionally, *Ferrel* is non-analogous art and cannot be properly used in the proposed combination. *See In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

A.   ***Hollingsworth*, *Ferrel*, and *Belanger*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 1-10, 12, and 14.**

Consider Claim 1, which recites:

A method, comprising the steps of:
providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;
storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an

output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

      executing said project definition; and

      automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images.

Appellant respectfully submits that *Hollingsworth*, *Ferrel*, and *Belanger*, whether taken alone or in combination, fail to teach or suggest all elements of Claim 1, and therefore the Examiner's rejection under § 103 based on the *Hollingsworth-Ferrel-Belanger* combination must fail.

Among other elements, *Hollingsworth*, *Ferrel*, and *Belanger* fail to teach or suggest: (1) providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data and (2) automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images.

In general, *Hollingsworth* teaches a reference model for workflow management (WFM) systems and provides a framework to support the development of specifications for workflow products in order to promote interoperability. *Hollingsworth*, § 1.2. The primary characteristic of WFM "is the automation of processes involving combinations of human and machine-based activities, particularly those involving interaction with IT applications and tools." *Id.* at § 1.1. *Hollingsworth*'s WFM systems provide support in three functional areas: build-time functions, run-time control functions, and run-time interactions with human users. *Id.* at § 2.1.

Ferrel generally teaches an on-line information retrieval server that indexes and searches stories, images, sound clips, and other content objects in titles. *Ferrel*, col. 4, ll. 2-5. The information retrieval server interrelates title, section, and story objects and creates a routing table that is used to locate objects across multiple database partitions. *Id.* at col. 4, ll. 10-14. The server can search for particular stories according to predetermined parameters or

in response to a user's input in a "find" dialog. *Id.* at col. 4, ll. 15-21. The retrieved stories are concatenated and inserted into a page layout. *Id.* at Abstract.

In general, *Belanger* teaches a method "for analyzing, identifying, and comparing images." *Belanger*, col. 1, ll. 61-63. Identified images can be "authenticated, registered, marked, compared to another image, or recognized." *Id.* at col. 1, ll. 64-67. *Belanger* determines unique image characteristics from an image's displayed composition. *Id.* at col. 2, ll. 1-2. For example, an "expressed color value" can be determined from the plurality of color values in an image. *Id.* at col. 2, ll. 12-16. Finally, *Belanger* teaches a method of determining whether a second image is a duplicate of a first image. *Id.* at col. 2, ll. 21-31.

1. ***Hollingsworth, Ferrel,*** **and** ***Belanger*** **fail to teach or suggest "providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data "**

Claim 1 requires "providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data." The proposed *Hollingsworth-Ferrel-Belanger* combination fails to teach or suggest these claimed aspects. As teaching these claimed aspects, the Examiner seems to point to both *Hollingsworth* and *Ferrel*. *Final Office Action*, p. 2-3.

Regarding *Hollingsworth*, the Examiner states:

> providing a set of predetermined process definitions (see sections 2.1-2.1.1, pages 6-8) including different process activity steps within the process (page 14),
> one process definition defining a process for processing data (section 2.1.3 on page 8, sub-processes suited to specific data type see page 19) including image data (section 2.2.1 on page 10);

Id. at p. 2 (sic). *Hollingsworth* defines its process definition as "[t]he computerized representation of a process that includes the manual definition and workflow definition." *Hollingsworth*, § 2.1.1. In *Hollingsworth*, a business process is translated from the real world into a formal, computer processable definition -- this resulting definition is *Hollingsworth*'s process definition. *Id.* Thus, *Hollingsworth*'s process definition fails to teach or suggest the claimed set of <u>predetermined</u> function definitions. Moreover, with regard to "editing image data," the Examiner cites *Hollingsworth*, section 2.2.1, which merely states that "[w]orkflow has been closely associated with image systems and many

image systems have workflow capability either built-in or supplied in conjunction with a specific workflow product." *Id.* at § 2.2.1. Appellant respectfully submits that this fails to teach or suggest "at least one of said predetermined function definitions defining a function for editing image data," as required by Claim 1.

> Regarding *Ferrel*, the Examiner states:

> > Ferrel teaches "process definition", including a multimedia publishing business system providing a set of predetermined different function definitions (Fig. 1) for providing dynamic online content, said system comprising function components including a function (194) for editing image (Fig. 2, col 10/lines 34-49);

Final Office Action, p. 3. However, the cited portion of *Ferrel* states:

> The Designer 194 is an extensible design and development environment that includes several preferred software components. These include . . . [Figure 2: elements 184, 186, 187, and 189]; and optional third-party tools, such as a sound editor 190, an image editor 192, and another media object editor 193 to create and modify sound, image, video, animation and other content objects.

Ferrel, col. 10, ll. 34-45. Accordingly, Appellant respectfully submits that *Ferrel* fails to teach or suggest <u>predetermined</u> function definitions or "at least one of said predetermined function definitions <u>defining a function</u> for editing image data." The cited portion of *Ferrel* merely teaches that "an image editor 192 [can be used] to create and modify sound, image, video, animation and other content objects." *Id.* This fails to teach or suggest the claimed aspects.

Moreover, Claim 1 further requires "storing a project definition . . . <u>which includes</u>: a plurality of function portions <u>which each correspond to one of said function definitions</u> in said set." Appellant respectfully submits that *Hollingsworth* and *Ferrel* fail to teach or suggest these claimed aspects. *Belanger* fails to teach or suggest any editing of images and thus fails to remedy the deficiencies of *Hollingsworth* and *Ferrel*.

Appellant thus respectfully submits that *Hollingsworth*, *Ferrel*, and *Belanger*, whether taken alone or in combination, fail to teach or suggest, "providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data," as required by Claim 1. Likewise, independent Claim 7 includes limitations that, for substantially similar reasons, are not taught or suggested by the references. Because the *Hollingsworth-Ferrel-Belanger* combination fails to teach or suggest every element of independent Claims 1 and 7,

Appellant respectfully requests reconsideration and allowance of Claims 1 and 7, and their respective dependent claims.

> **2.** ***Hollingsworth, Ferrel,* and *Belanger* fail to teach or suggest "wherein transmitting said communication occurs after editing a predetermined number of images."**

Claim 1 requires "automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images." *Hollingsworth, Ferrel,* and *Belanger,* whether taken alone or in combination, fail to teach or suggest these claimed aspects.

As teaching these claimed aspects, the *Final Office Action* points to all three references, but clarifies:

> Although [*Hollingsworth* and *Ferrel*] teach transmitting a communication after edit said image data, they do not explicitly teach where the condition includes a predetermined number of images.
>
> Belanger teachings in the field of endeavor of automated processing of data, teaching a notification feature including transmitting a communication (col 9/lines 32-42), including transmitting a communication, e.g. a notifying after processing a predetermine number of images data (col 9/lines 22-64).

Final Office Action, p. 4 (sic). Accordingly, Appellant assumes that the *Final Office Action* relies on *Belanger* to teach or suggest "wherein transmitting said communication occurs after editing a predetermined number of images."

However, *Belanger* fails to teach or suggest these claimed aspects. The cited portions of *Belanger* discuss responding to a possible duplicate image. *Belanger* teaches that, after discovering a possible duplicate image, a secondary comparison can be performed: "[f]or example, a possible duplicate image can be reloaded to the computer and compared to the reference image using pattern matching, quadrant frequency, usage counts, or any other applicable method." *Belanger,* col. 9, ll. 27-30. *Belanger* fails to teach, suggest, or even mention any editing, modifying, or changing of image data.

Thus, even assuming, for the sake of argument, that *Belanger* teaches sending a notification when a predetermined number of images condition is satisfied, as asserted by the Examiner, *Belanger* still fails to teach or suggest wherein transmitting the communication occurs after <u>editing</u> a predetermined number of images, as required by Claim 1. Generally,

Belanger teaches a method and apparatus for "analyzing, identifying, and comparing images." *Belanger*, col. 1, ll. 61-63. The cited portions of *Belanger* discuss an alarm or notification feature to be sent or displayed "every ten minutes, every time an image match is found, every time ten image matches are found, when no image match is found, to identify the total number of images . . ." *Final Office Action*, p. 6 (citing *Belanger*, col. 9, ll. 45-51). Even if *Belanger* teaches <u>analyzing</u> a predetermined number of images, *Belanger* does not teach or suggest <u>editing</u> a predetermined number of images, much less other claimed aspects.

Hollingsworth and *Ferrel* fail to cure the deficiencies of *Belanger*. As the Examiner notes, these references fail to "explicitly teach where the condition includes a predetermined number of images," but the Examiner relies on these references as teaching "transmitting a communication after edit said image data." *Final Office Action*, p. 4 (sic). However, the cited portion of *Hollingsworth* merely states, "Workflow has been closely associated with image systems and many image systems have workflow capability either built-in or supplied in conjunction with a specific workflow product." *Hollingsworth*, § 2.2.1. The cited portions of *Ferrel* merely describe image editor 192 in a publisher workstation that can be used to "create and modify sound, image, video, animation and other content objects." *Ferrel*, col. 10, ll. 42-45. Appellant respectfully submits that the combination of *Hollingsworth* and *Ferrel* likewise fails to teach or suggest wherein transmitting said communication occurs after editing a predetermined number of images.

Appellant thus respectfully submits that *Hollingsworth*, *Ferrel*, and *Belanger*, whether taken alone or in combination, fail to teach or suggest, "automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images," as required by Claim 1. Likewise, independent Claim 7 includes limitations that, for substantially similar reasons, are not taught or suggested by the references. Because the *Hollingsworth-Ferrel-Belanger* combination fails to teach or suggest every element of independent Claims 1 and 7, Appellant respectfully requests reconsideration and allowance of Claims 1 and 7, and their respective dependent claims.

B.   **The proposed *Hollingsworth-Ferrel-Belanger* combination is improper because there is no teaching, suggestion, or motivation to combine or modify the teachings of the references.**

Appellant respectfully submits that Claims 1-10, 12 and 14 are patentable over the cited references because there is no teaching, suggestion, or motivation to combine or modify the teachings of the references.

According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation . . . is an 'essential component of an obviousness holding.' " *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225 (Fed. Cir. 1998)). Furthermore, while "evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, ... [t]he range of sources available . . . does not diminish the requirement for actual evidence." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001).

Nothing in *Hollingsworth, Ferrel*, or *Belanger* suggests or motivates the proposed combination. The Examiner, in the *Final Office Action*, merely states that the teachings of one reference would improve the teachings of another reference:

> It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Hollingsworth of the applicability of his teachings to image processing applicable in other information technology application, the teachings of Ferrel for information distribution including image processing would be readily apparent. One would be motivated to apply the secondary reference's teaching because in doing so, multiple users via the work-list/work-item supported by the plurality of communication protocols taught by Hollingsworth, may have content available for retrieval image data in one of several formats including image data and document data or a combination thereof, wherein the common source library database may store any type of data which can be repeatedly used, as suggested by Ferrel.

Final Office Action, page 4 (sic). Further, with respect to the combination of *Belanger* and *Hollingsworth* and *Ferrel*, the Examiner states:

> It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of given the suggestions of Hollingsworth for associating image systems with computerized facilitation or automation of business process and IT applications, the teachings of Belanger for information technology particularly images would be readily apparent. One would be motivate to given Hollingsworth means for identifying the state of individual process or activity via specific commands, e.g. query process status for the number of images processed as a percentage from the total number of images on the site or electronic network pending to be processed or the total of predetermined number of image data. One would be motivated to applied Belanger teaches in Ferrel's system enabling the detection of copied images for enforcing owner's copyrights in Ferrel's publishing environment providing information retrieval services, as suggested by Belanger.

Id. (sic.)

First, Appellant respectfully argues that the Examiner misstates the teachings of the references. Also, Appellant notes that the Examiner fails to provide any citation to the references relied upon as providing these alleged suggestions to combine or modify.

Third, nothing in *Hollingsworth, Ferrel,* or *Belanger* suggests or motivates the proposed combination. *Hollingsworth* addresses workflow management technology involving combinations of human and machine-based activities; *Ferrel* deals with an information retrieval server that indexes, searches, and retrieves online content and stories; and *Belanger* deals with methods for analyzing, identifying, and comparing identified images. These disparate fields of endeavor highlight the dramatic differences between the teachings of each references. Thus, someone searching for references related to one reference would be hard pressed to come across the other two, and even more hard pressed to find a motivation to combine the references.

Finally, Appellant respectfully submits that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any portions of the references or other known authority, and therefore is not based on objective evidence of record. Thus, the *Final Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art.

For at least this reason, the *Office Action* fails to present a *prima facie* case of obviousness. Appellant therefore respectfully submits that Claims 1-10, 12 and 14 are allowable over the cited references.

C. *Ferrel* is non-analogous art and cannot be properly combined.

The *Hollingsworth-Ferrel-Belanger* combination is improper because *Ferrel* is not analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention when considering his problem." *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992).

Ferrel is non-analogous art. *Ferrel* deals with an information retrieval server that indexes, searches, and retrieves online content and stories. Appellant respectfully submits that online publication methods are in a non-analogous field of endeavor.

For at least these reasons, Claims 1-10, 12 and 14 is patentable over the proposed combination of *Hollingsworth*, *Ferrel*, and *Belanger*. Appellant respectfully requests reconsideration and allowance of Claims 1-10, 12 and 14.

II. Section 101 Rejection: Claim 1 is Directed to Statutory Subject Matter.

The Examiner rejects Claim 1 under 35 U.S.C. 101 as directed to non-statutory subject matter. Appellant traverses this rejection. In the *Previous Office Action* (mailed September 21, 2005), the Examiner rejected Claim 1, stating:

> The method claim 1 do not seem to be described as being implemented in any tangible and/or limited to any tangible embodiment(s) (e.g. hardware components). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Previous Office Action, p. 7 (sic). Appellant understands this to be the basic reason for rejection presented in the *Final Office Action*. Appellant respectfully submits that Claim 1, a method claim, need not be "limited to any tangible embodiment(s) (e.g. hardware components)," as asserted by the Examiner.

In section 101, Congress deemed that "any new and useful process" constitutes patentable subject matter:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101. The Supreme Court and Federal Circuit have interpreted the statute broadly, stating that statutory subject matter should essentially "include anything under the sun that is made by man." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1355 (Fed. Cir. 1999) (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)). The courts have, however, specifically identified three categories of unpatentable subject matter: laws of nature, natural phenomena, and abstract ideas. *Id.* (citing *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)). A mathematical formula or algorithm in the abstract is also considered to be unpatentable subject matter. *Id.* at 1356. But, "[b]ecause § 101 includes processes as a category of patentable subject matter, the judicially-defined proscription against patenting of a 'mathematical algorithm,' to the extent such a proscription still exists, is narrowly limited to mathematical algorithms in the abstract." *Id.*

The Federal Circuit has clarified that a method claim qualifies as patentable subject matter when it "produces a useful, concrete, [and] tangible result." *Id.* at 1358. There is no requirement of a physical transformation, or the like. *Id.*

Appellant submits that Claim 1 produces a useful, concrete, and tangible result and, thus, is directed to statutory subject matter. Claim 1 does not identify a law of nature, natural phenomenon, or abstract idea. Claim 1 is not an abstract mathematical algorithm. It requires "storing a project definition," "executing said project definition," and "transmitting a communication to a remote device." Instead of constituting nonstatutory subject matter, Claim 1 produces a useful, concrete, and tangible result.

Thus, Appellant respectfully submits that Claim 1 is directed to statutory subject matter. Because Claim 1 is directed to statutory subject matter, Appellant respectfully requests reconsideration and allowance of Claim 1.

CONCLUSION

Appellant has demonstrated that the present invention, as claimed in Claims 1-10, 12, and 14, is patentably distinct from the cited art and that Claim 1 is directed to statutory subject matter. Accordingly, Appellant respectfully requests that the Board reverse the final rejection and instruct the Examiner to issue a Notice of Allowance of Claims 1-10, 12, and 14.

Appellant believes that the Commissioner has previously charged $500.00 for the filing fee to Deposit Account No. 02-0384 of Baker Botts L.L.P and that no fee is currently due. The Commissioner is hereby authorized to charge any extra fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: December 5, 2006

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Appendix A: Claims Involved In Appeal

1.   (Previously Presented) A method, comprising the steps of:

providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;

storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

executing said project definition; and

automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images.

2.   (Original) A method according to Claim 1, including the step of carrying out said transmitting step as said executing step is completing.

3.   (Original) A method according to Claim 1, including the step of formatting said communication as an electronic mail message.

4.   (Original) A method according to Claim 1, including the step of configuring said communications link to include a network.

5.   (Original) A method according to Claim 4, including the step of configuring said network to include a portion of the Internet.

6.   (Original)   A method according to Claim 1, wherein said transmitting step includes the step of causing one of said function portions to send the communication.

7.   (Previously Presented)   A computer-readable medium encoded with a computer program which recognizes a set of predetermined function definitions that are different, at least one of said predetermined function definitions defining a function for editing image data, said program being operable when executed to facilitate:

storing of a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

execution of said project definition; and

automatic transmission of a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmission of said communication occurs after editing a predetermined number of images.

8.   (Original) A computer-readable medium according to Claim 7, wherein said program is operable when executed to effect said transmission of said communication as the execution of said project definition is completing.

9.   (Original) A computer-readable medium according to Claim 7, wherein said program is operable when executed to format said communication as an electronic mail message.

10.   (Original) A computer-readable medium according to Claim 7, wherein said program is operable when executed to cause one of said function portions to effect said transmission of said communication.

11.   (Canceled)

12.   (Previously Presented) A method according to Claim 1, wherein said communication identifies an occurrence of a predefined condition.

13.   (Canceled)

14.   (Previously Presented) A computer-readable medium according to Claim 7, wherein said communication identifies an occurrence of a predefined condition.

Appendix B: Evidence

NONE

Appendix C: Related Proceedings

NONE